

PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number
21790-08920

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on _____

Signature _____

Typed or printed name _____

Application Number
09/919,567Filed
July 30, 2001First Named Inventor
John J. DooleyArt Unit
3627Examiner
Michael A. Cuff

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor./Jennifer R. Bush/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

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Registration number if acting under 37 CFR 1.34 _____

September 18, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".

**REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW IN U.S.
PATENT APPLICATION NO. 09/919,567 FILED ON 07/30/2001**

Pre-appeal brief review is appropriate in this application, because the rejections in the April 18, 2008 Final Office Action ("FOA 4/18/08" herein) contain clear deficiencies. The FOA failed to address several claim limitations, and the cited Tantry and Friedman references fail to disclose the claimed limitations, as recited in claims 24-46, and thus *prima facie* obviousness required by MPEP §2143.03 has not been established.

**Improper Final Rejection:
Unaddressed Claim Limitations & Continued Cursory Treatment**

In the Request to Withdraw Finality of Rejection filed June 18, 2008 (RWFR herein), p. 7-8, Applicants discussed unaddressed claim limitations believed to make the finality of FOA 4/18/08 improper. In the In the Advisory Action dated July 17, 2008 ("AA 7/17/08"), the Examiner responds to Applicants' itemization of the unaddressed claim limitations, *inter alia*, that since the cited references allegedly show the Description Document, they "would have had to collect, gather, organize or generate the specification information," and cites 37 C.F.R. 1.104(c)(2), asserting that "this type of sema[n]tic delineation falls under the realm of what is apparently disclosed" per this section. AA 7/17/08, p. 2, first para.

Applicants are unclear as to why the Examiner cites 37 C.F.R. 1.104(c)(2), which recites: "the examiner must cite the best references at his or her command... the particular

part relied on must *be designated as nearly as practicable*,... and *each rejected claim specified*” (emphasis added). Contrary to containing any statements about what is “apparently disclosed,” this section recites **precisely** the requirements with which Applicants assert that the Examiner has not complied. The Examiner’s additional conclusory assertions that “these steps are broad and almost redundant” and the claims are “so broad” that the rejection “is equally applicable to the apparatus and method claims,” does not relieve the Examiner of his obligation to provide complete examination under 37 C.F.R. 1.104. In addition, AA 7/17/08 is only partially responsive to Applicants’ assertions regarding the unaddressed claim limitations. E.g., the Examiner never has addressed the limitation “wherein the data center **sends the mapping of the event information to the one or more site servers**,” as recited in dependent claims 25, 32, and 40.

Applicants note that this is the second Pre-Appeal Brief Request for Review submitted in this case. The first was submitted with the Notice of Appeal filed July 17, 2007 (“Remarks 7/17/07” herein). Applicants maintain and hereby incorporate by reference the arguments discussed on pp. 1-2 of Remarks 7/17/07, and note that the deficiencies discussed therein with respect to the omnibus and cursory treatment of the claims never have been remedied by the Examiner. Indeed, in the six (6) office actions since the Tantry reference was first cited in the Office Action dated July 13, 2005, the Examiner has never once separately addressed even the independent claims, nor cited a column and line number within Tantry in support of his assertions. The rejection of the 22 pending claims with respect to Tantry never has exceeded 10 lines of text.

Thus, Applicants submit that not all limitations of the pending claims have been addressed, which substantially affects Applicants' ability to properly respond thereto. In the interest of furthering prosecution, Applicants have attempted to address the Examiner's rejections below based on the limited information provided.

Response to Rejection Under 35 USC §103(a)

In the Final Office Action, Examiner rejects claims 24-46 under 35 USC § 103(a) as allegedly being unpatentable over Tantry in view of Friedman. This rejection now is traversed.

Applicants refer to and hereby incorporate by reference the arguments presented at RWFR, p. 9-13, some of which are referenced below.

In the Advisory Action, the Examiner asserts that Tantry has a mapping table because it "maps callback routines from equipment to application engine functionality," and is "merely silent on how the table is formed." AA 7/17/08, p. 2, second para. First, Applicants note that Tantry does not *recite* any mapping table. Second, claim 1 recites that the mapping table is "**based on** the Description Document." Assuming, *arguendo*, that the "user interface widget library" shows the Description Document as the Examiner asserts (FOA 4/18/08, p. 2), then the mapping table would need to be *based on* the user interface widget library. Tantry's widget library is understood to be a record of what machine worked on which widgets. *See* Tantry, col. 7, ll. 10-13. Thus, a mapping table based on this information is inconsistent with both the claim language and the Examiner's rationale quoted above with respect to the mapping table.

In addition, Applicants disagree that Tantry shows the claimed Description Document for the reasons discussed in the Remarks 7/17/07, p. 6. Applicants note that the Examiner indicated in the Final Office Action dated April 17, 2007, p. 5, that “introduc[ing] the Description Document in the independent claim and link[ing] it to the generation of the mapping table” would overcome the similar rejection of the claims in that action. Applicants subsequently made the suggested amendment. Applicants note that the Description Document is specifically defined in the specification. While the Examiner should apply the broadest *reasonable* interpretation to claim terms, the reasonableness limitation requires that the construction not be so broad so as to conflict with the specification. *See, e.g., In re Buszard* (Fed. Cir. 2007), *discussed at the Biotechnology/Chemical/Pharmaceutical Customer Partnership, Broadest Reasonable Interpretation Standard* (J. Gongola, Associ. Solicitor, U.S.P.T.O.), Sept. 9, 2008.

Friedman does not remedy these deficiencies, nor does the Examiner argue that it does. With respect to reliance on Friedman for the mapping itself, Friedman also is deficient for the reasons described at RWFR, p. 10.

With respect to the suggested combination, the references **both** teach away from such combination, and the elements of Tantry and Friedman are being modified for use well beyond their established functions, such that the “predictability” of the combination is precluded. *See KSR*, 127 S.Ct. 1727, 1739 (2007). *See RWFR*, p. 11-12.

Thus, Tantry and Friedman, alone or in the suggested combination, do not disclose or suggest all the claimed elements of claim 1. Independent claims 31, 38, 39, and 46, although not coextensive in scope, recite similar limitations to those distinguished above

over the cited references and thus also are patentably distinguishable for at least the above reasons.

Claims 25-30, 32-37, and 40-45 variously depend from claims 24, 31, and 39, which were shown above to be patentable over the cited references and which recite additional patentably distinguishable features not shown in the cited references. For these reasons, Applicants submit that claims 25-30, 32-37, and 40-45 also are patentably distinguishable over the cited references.

Therefore, it is requested that the final rejections of independent claims 24, 31, 38, 39, and 46, and their dependent claims 25-30, 32-37, and 40-45 be withdrawn.

Respectfully submitted,
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